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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/771,621	02/04/2004	Craig A. Schmitt	00635-234001	9508

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EXAMINER

HOOK, JAMES F

ART UNIT PAPER NUMBER

3754

DATE MAILED: 03/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/771,621

Applicant(s)

SCHMITT, CRAIG A.

Examiner

James F. Hook

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 1-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-26 are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                | Paper No(s)/Mail Date. ____.  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>8-16-04</u> .   | 6) <input type="checkbox"/> Other: ____.                                    |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, drawn to a manifold including a filter and membrane, classified in class 210, subclass 321.6.
  - II. Claims 17-26, drawn to a flow restrictor, classified in class 138, subclass 43.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the restrictor in claim 1 of group I does not require the tapering conical wall defining the housing, the plug, and the spiral liquid flow path, or the configurations of claims 18-23. The subcombination has separate utility such as restriction of flow in any other conduit other than a filtration or manifold system, e.g. liquid distribution system.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Timothy A. French on 1/28/04 a provisional election was made with traverse to prosecute the invention of group II, claims 17-26. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Any inquiry concerning the restriction requirement should be directed to Ana M Fortuna whose telephone number is (571) 272-1141. The examiner can normally be reached on 9:30-6:00 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wanda L. Walker can be reached on (571) 272-1151. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 20 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 20 recites the limitation "said insert" in line 2. There is insufficient antecedent basis for this limitation in the claim. There is no clear structure set forth in the claims which defines what structure is meant to be covered by "said insert", where it's not clear if such is intended to be further structure or some previously claimed structure, and therefore the scope of the claim is not clear and no art may be applied since the examiner would need to know what part was considered the insert to ascertain what is made of softer material.

Claims 25 and 26 appear to also lack antecedent basis, however, such appears to be caused by the dependency of these claims on claims 17 and 19 respectively when it appears such a limitation of "said port" is set forth in claim 24, and it is believed these claims were inadvertently made dependent from the other independent claim instead of claim 24 which appear to be the proper claim from which they should depend.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17-19 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Waller. The patent to Waller discloses the recited flow restrictor defining a restricted flow path comprising a housing 12 defining an elongated conduit having a tapered conical wall defining a first screw thread 28,30 between a first and second opening for fluid flow, an axially elongated plug 32 is received in the conduit, a surface of the plug opposed to the tapering conical wall defines a second screw thread and a tapering surface, the second screw thread is in threaded engagement with the first screw thread, where fluid can flow through the gap between the screw threads thereby inherently creating a fluid channel, where the use of water is merely intended use where the apparatus of Waller is capable of use with water, the threaded channel is spiral and extends from the first opening to the second opening, the plug is received through the second opening, the limitation of how the plug and housing are formed is merely a method limitation which appears to provide no patentable weight to the article in that it is not clear that such method would change the final article or how it functions, where the channel formed by the plug and housing creates a port along with the exit opening.

Claims 17-19 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith. The patent to Smith discloses the recited flow restrictor defining a restricted flow path comprising a housing 12 defining an elongated conduit having a tapered conical wall defining a first screw thread 72 between a first and second opening for fluid flow, an axially elongated plug 34 is received in the conduit, a surface of the plug opposed to the tapering conical wall defines a second screw thread and a tapering surface, the second screw thread is in threaded engagement with the first screw thread, where fluid can flow through the gap between the screw threads thereby inherently creating a fluid channel, where the use of water is merely intended use where the apparatus of Waller is capable of use with water, the threaded channel is spiral and extends from the first opening to the second opening, the plug is received through the second opening, the limitation of how the plug and housing are formed is merely a method limitation which appears to provide no patentable weight to the article in that it is not clear that such method would change the final article or how it functions, where the channel formed by the plug and housing creates a port along with the exit opening.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 21 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Waller in view of Bryant. The patent to Waller discloses all of the recited structure

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with the exception of forming the threads as a pointed protrusion that penetrates the tapered surface. The patent to Bryant discloses the recited restrictor comprising a housing 17 which can be seen to have a conical wall in figure 3 where a plug 16 is provided therein, and has screw threads 20a which can be seen to penetrate the conical wall surface and thereby such has threads also. It would have been obvious to one skilled in the art to modify the plug of Waller to have any shape threads including pointed where such is merely a choice of mechanical expedients and an obvious alternate shape of threads on threaded plugs in restrictors, and allow the threads to penetrate the surface where such would provide for better control of flow as suggested by Bryant and would increase the efficiency of the plug and thereby inherently save money.

Claim 23 is rejected under 35 U.S.C. 103(a) as being unpatentable over Waller or Smith in view of Pett. The patents to Waller and Smith disclose all of the recited structure with the exception of forming a gap in the threads of the plug to allow for alternate flow paths. The patent to Pett discloses that it is old and well known in threaded restrictors to provide a gap in threads to thereby form a second and third thread on the plug and allow for a different flow pattern. It would have been obvious to one skilled in the art to modify the plug in Smith or Waller by providing a gap in the threads of the plug to create second and third threaded portions as suggested by Pett where such would change the flow characteristics of the restrictor and allow for a greater range of uses thereby saving money.



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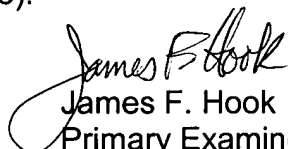
***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Goldberg, Ifield, Kauss, Carton, Gustin, Tooth, Begemann (433 and 063), and Ziv-Av disclosing state of the art restrictors.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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James F. Hook  
Primary Examiner  
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JFH